

Attorney Docket No.: 231555US-33

TTAB



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

YOSHIDA METAL INDUSTRY CO., LTD.,)

Opposer,)

v.)

GLOBAL DÉCOR,)

Applicant.)

Opposition No. 91/156,618

U.S. Appln. Serial No. 76/179,674



11-10-2003

U.S. Patent & TMO/TM Mail Rpt Dt. #22

OPPOSER'S REPLY IN SUPPORT OF MOTION FOR FURTHER DISCOVERY
UNDER FED. R. CIV. P. 56(f) AND FOR ORDER COMPELLING DISCOVERY

Opposer, Yoshida Metal Industry Co., Ltd. ("Opposer"), submits this Reply in support of its Motion for Further Discovery under Fed. R. Civ. P. 56(f) and for Order Compelling Discovery ("Opposer's Motion"), and in support states that Opposer's Motion is consistent with the Trademark Rules of Practice and applicable case law.

The Board rule governing the suspension of proceedings pending the resolution of a motion for summary judgment expressly provides for further filings that are germane to the motion. TBMP § 528.03. A motion for additional discovery under Rule 56(f) of the Federal Rules of Civil Procedure is precisely the type of matter envisioned by the rules as one germane to a motion for summary judgment, and the TBMP so provides. *See* TBMP § 528.03 ("Examples of papers which are or may be germane to a motion for summary judgment include... a motion under FRCP 56(f) for discovery to enable the nonmoving party to respond to the summary judgment motion").

In addition, Opposer's additional request to compel is appropriate and was included for the sake of completeness because Rule 56(f) does not distinguish between a situation where Opposer asserts that the summary judgment movant's discovery responses are insufficient and a situation where there are no discovery responses at all. Opposer availed itself of the opportunity to serve discovery on Applicant at the earliest opportunity. Although Applicant's responses to Opposer's discovery requests were originally due prior to the date Applicant's summary judgment motion was served, Opposer had agreed to an extension of time for these responses. Opposer's voluntary extension permitted Applicant to file its Motion for Summary Judgment. Opposer should not be disadvantaged by its good faith efforts to facilitate discovery in this matter.

Opposer complied with Trademark Rule 2.120(e) governing motions to compel by including copies of the requests and responses for which its motion seeks to compel further responses. Copies of Applicant's Response to Opposer's First Set of Interrogatories, Applicant's Responses to Opposer's First Request for Production of Documents, and Applicant's Response to Opposer's First Requests for Admissions, with copies of the interrogatories and requests reproduced therein, were appended to Opposer's original motion filed with the Board and to the copy of the motion served on Applicant as Exhibits C, D, and E to Opposer's Motion.

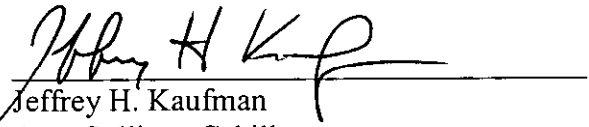
Finally, although the primary objective of Opposer's motion was for the opportunity for additional discovery under Fed. R. Civ. P. 56(f), Opposer complied with its good faith requirement to resolve the related discovery conflict imposed by Trademark Rule 2.120(e), and so stated in Opposer's Motion.

A copy of Opposer's counsel's correspondence addressing the dispute and Applicant's counsel's response are attached hereto as collective Exhibit A.

Respectfully submitted,

YOSHIDA METAL INDUSTRY CO., LTD.

By:



Jeffrey H. Kaufman
Amy Sullivan Cahill
OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
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Alexandria, Virginia 22314
(703) 413-3000
Fax: (703) 413-2220
Attorneys for Opposer

Dated: November 10, 2003

JHK/ACS/plk {I:\atty\jkh\4646-231555US-rply-rule56.doc}

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing **OPPOSER'S REPLY IN SUPPORT OF MOTION FOR FURTHER DISCOVERY AND FOR ORDER COMPELLING DISCOVERY** was served on counsel for Applicant, this 10th day of November, 2003, by sending same via First Class mail, postage prepaid, to:

James B. Conte, Esquire
Barnes & Thornburg
One North Wacker Drive, Suite 400
Chicago, Illinois 60606-2809

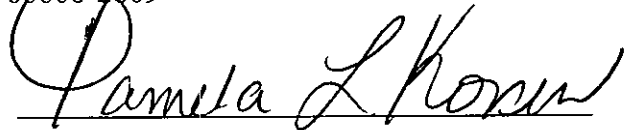

Pamela L. Korn

EXHIBIT A

From: Amy Cahill
To: "jconte@btlaw.com".GWIA.OSGW
Date: 9/30/03 12:13PM
Subject: RE: Yoshida Metal Industry Co., Ltd. v. consent means w Global Decor

Mr. Conte:

In preparing our reply to Applicant's motion for summary judgment, we have again reviewed Applicant's responses to Opposer's First Set of Interrogatories and First Request for Production of Documents. We continue to find these responses to be inadequate, particularly with respect to Applicant's refusal to produce any responsive documents to date, notwithstanding the parties' previous agreement to treat confidential documents as "attorneys eyes only" until a protective order could be agreed on.

Given the insufficient information and documentation provided, we have no choice but to request an opportunity for further discovery and for an Order from the Board directing Applicant to produce the information and documents requested, in order adequately to respond to Applicant's Motion for Summary Judgment. Unless you are able to supplement these responses by our deadline of October 1, 2003, we will seek the Board's assistance and move to compel Applicant's responses. Of course, filing a motion under Rule 56(f) would obviate the need for a request for extension of time to respond to the pending motion.

Amy Sullivan Cahill

>>> "Conte, James" <jconte@btlaw.com> 09/29/03 06:24PM >>>

Your motion should include the resetting of the reply dates. My email consented to "an agreed motion resetting the response and reply dates". Additionally your own responsive email on the 24th confirmed you would file a single motion.

Separate motions create needless duplication, work and possible confusion for the TTAB.

You should file the single motion as you stated you would in your 24th email.

Sincerely,

J. Conte.

-----Original Message-----

From: ASULLIVAN@oblon.com [mailto:ASULLIVAN@oblon.com]
Sent: Thursday, September 25, 2003 11:10 AM
To: jconte@btlaw.com
Cc: JKAUFMAN@oblon.com
Subject: RE: Yoshida Metal Industry Co., Ltd. v. consent means w Global Decor

Mr. Conte:

We attach consented requests to extend Opposer's deadline to respond to Applicant's Motion for Summary Judgment until November 1 and to extend Applicant's time to file a reply in support of Applicant's Motion for Summary Judgment until January 19, 2004, as agreed.

If you do not object, we will proceed to file Opposer's request with the TTAB tomorrow (with a service copy to you). You may sign and file the Applicant's request at your convenience.

Thank you,

Amy Sullivan Cahill

>>> "Conte, James" <jconte@btlaw.com> 09/24/03 12:12PM >>>

You misunderstand. We will only agree to the 30 day extension provided you consent to move our reply date back to January 19. I use the term consent to mean we will file an agreed motion resetting the response and reply dates. If you do not want to file an agreed motion resetting the dates than you have not given us your consent and we do not consent to your extension.

Sincerely,

J Conte

-----Original Message-----

From: ASULLIVAN@oblon.com [mailto:ASULLIVAN@oblon.com]

Sent: Wednesday, September 24, 2003 10:24 AM

To: jconte@btlaw.com

Cc: JKAUFMAN@oblon.com

Subject: Re: Yoshida Metal Industry Co., Ltd. v. Global Decor

Mr. Conte:

Thank you for consenting to a thirty day extension of the period for Opposer to respond to Applicant's Motion for Summary Judgment in the above matter. In exchange, we agree not to object to an extension of Applicant's time for reply until January 19, 2003, to the extent that the extension is permitted by the Board under Trademark Rule 2.127.

Amy Sullivan Cahill

>>> "Conte, James" <jconte@btlaw.com> 09/23/03 08:35PM >>>

I received your voice mail message requesting an additional 30 days to respond to our motion for Summary Judgment. Granting the request will move my reply date into a particularly hectic period. Assuming you will consent to move our reply date back to January 19, 2004 we will consent.

CC: Kaufman, Jeffrey

From: "Conte, James" <jconte@btlaw.com>
To: "ASULLIVAN@oblon.com" <ASULLIVAN@oblon.com>
Date: 10/1/03 2:01PM
Subject: RE: Yoshida Metal Industry Co., Ltd. v. consent means w Global Decor

Dear Ms. Sullivan,

As we previously advised you by email, we are not withholding any documents based on objections raising the need for a protective order. As stated, we consider Yoshida's offer to treat all documents produced under the protection of the Attorneys Eyes Only designation acceptable.

We disagree with Yoshida's position concerning Rule 56(f).

Sincerely,

J. Conte

-----Original Message-----

From: ASULLIVAN@oblon.com [mailto:ASULLIVAN@oblon.com]
Sent: Tuesday, September 30, 2003 12:23 PM
To: jconte@btlaw.com
Cc: JKAUFMAN@oblon.com
Subject: RE: Yoshida Metal Industry Co., Ltd. v. consent means w Global Decor

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Amy Sullivan Cahill